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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,137	11/25/2003	Laurent C. Bissonnette	20002.0282A	4414
23517	7590	03/11/2005	EXAMINER	
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP 3000 K STREET, NW BOX 1P WASHINGTON, DC 20007			LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/720,137

Applicant(s)

BISSONNETTE ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 34-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 and 34-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 13-15 of U.S. Patent No. 6093357. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of USPN 6093357 are within the scope and breadth of claims 1-12 and 34-40 of the instant application.

3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The meaning of the claim is confusing. Specifically, the phrase "the center of the core is disposed within about 0.5mm from the midpoint" is confusing. Presumably, the center of the core is larger than 0.5mm in diameter thus it cannot be disposed within about 0.5mm from the midpoint.

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4. Claims 1-13 and 34-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "sufficient rigidity" (cl 1, ln 8; cl 34, ln 9) is indefinite because it is unclear whether or not it is related to the rigidity previously mentioned in the claim.

The phrase "at least two shells" (cl 1, ln 11; cl 34, ln 12) is indefinite because it is unclear whether or not the at least two shells is related to the shells previously mentioned in the claim.

The phrase "a ball core" (cl 1, lns 12-13; cl 34, lns 13-14) is indefinite because it is unclear whether or not it is related to the golf ball core previously mentioned in the claim. If they are the same then it should be positively and clearly stated as such.

Claim 2 is indefinite because it is unclear as to whether or not it is related to the step of forming the first mixture into a plurality of shells in a desired shape of claim 1. if the ellipsoidal shape is the desired shaped then it should be positively and clearly recited as such.

Claim 2 is indefinite because it is unclear whether or not the first mixture is actually formed into an ellipsoidal shape. If the first mixture is formed into ellipsoidal half-shells then it should be positively and clearly claimed as such.

Claim 6 is indefinite because it is unclear whether or not the claim is related to the forming step of claim 1. if "provided" (cl 6, ln 1) has the same meaning as "forming" (cl 1, ln 7) then it should be positively and clearly recited as such.

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Claim 7 is indefinite because it is confusing. see the above 35 USC 112, first paragraph rejection.

The phrase "adjusting the tensile storage modulus" (cl 9, ln 3) is indefinite because it is unclear as to which component's modulus is being adjusted. If it is the modulus of the crosslinked first mixture then it should be positively and clearly claimed as such.

The phrase "the melting temperature" (cl 10, ln 1) is indefinite because it is unclear to which component's melting temperature is being referred. If it is the resilient polymer's melting temperature then it should be positively and clearly recited as such.

The phrase "the crosslinking temperature" (cl 10, lns 1-2) is indefinite because it is unclear to which component's crosslinking temperature is being referred. If it is the resilient polymer's crosslink temperature then it should be positively and clearly recited as such.

Claim 11 is an improper Markush group.

Claim 39 is an improper Markush group.

Clarification and/or correction is required.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,4,7,10-13 and 34-40 rejected under 35 U.S.C. 102(b) as being anticipated by Kim et al. (USPN 5184828). Kim et al teach the claimed process as

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evidence at col 3, ln 65-col 6, ln 35; col 6, ln 66-col 7, ln 15). It should be noted that the isoprene rubber of Kim constitutes the claimed reinforcing polymer. As a note, the golf ball core of Kim et al inherently has a midpoint and the center of the core is within about 0.5mm from the midpoint because the diameter of the center is much greater than 0.5mm; and the isoprene rubber inherently possess a crystalline melting temperature within the instant claimed range. Also it is inherent that the uncrosslinked mixture of Kim et al has a flexural modulus of greater than about 3.5 MPa because Kim et al teach all of the claimed ingredients, process steps, and process conditions.

Note: if it is applicant's position that the inherence of the flexural modulus of greater than about 3.5 MPa is not the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only the claimed steps.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2,3,5,6,8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (USPN 5184828). The above teachings of Kim et al are incorporated hereinafter. Kim et al do not teach forming an ellipsoidal shape; using a component having the claimed molecular weight; forming by injection molding; forming by compression molding; and the limitations of claim 9. In regard to forming an

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ellipsoidal shape, it is generally well-known in the golf ball art to form ellipsoidal half-shells in order to better control the material flow of the shell during its curing. Further, forming the mixture into an ellipsoidal shape is a mere obvious matter of choice dependent on mold design and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the mixture of forming an ellipsoidal shape; using a component having the claimed molecular weight; forming by injection molding; forming by compression molding; and the limitations of claim 9 into an ellipsoidal shape for the above reason. In regard to using a component having the claimed molecular weight, it is notoriously well-known in the golf ball art to use of high molecular weight average cis-1,4-polybutadiene for its physical stability. Further, a resilient polymer having a molecular weight average within the claimed range is a mere obvious matter of choice dependent on the desired final product and of little patentable consequences to the claimed method since it is not a manipulative feature or step of the claimed method. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cis-1,4-polybutadiene having a molecular weight average within the claimed range in the process of Kim et al for the above reason. In regard to forming by injection molding, such is well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the half-shells of Kim et al by injection molding in order to improve efficiency. In regard to forming by compression molding, such is well-known in the golf ball art. Thus, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to form the half-shells of Kim et al by compression molding in order to improve efficiency. In regard to the limitations of claim 9, it is well-known in the molding art and polymer science to adjust the loss tangent and tensile modulus of a crosslinked polymer to achieve a certain desired physical property such as strength and stability. The specific amount of adjusting is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the desired adjustments would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the claimed adjustments to the material of Kim et al in order to have a material with greater strength and stability.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL


3/7/05